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Confirmation No.:1424

ademark Office at (871) 273-8390.  
  
 Kathy Stehle

The issue presented in this petition relates to post-appeal practice when the Board overturns the rejection of a dependent claim and upholds the rejection of other dependent claims. Clearly, the rules require that the allowable dependent claims be rewritten in independent form. The question that remains is what happens to the remaining dependent claims? Applicant took the position that amending the remaining dependent claims to depend from an allowable independent claim placed the application in condition for allowance.

However, the Patent Office took the position that only the claims whose rejections were reversed by the Board could be rewritten and allowed, and that all other pending dependent claims, even if dependent on an allowable independent claim, must be cancelled by the Applicant. As discussed further below, neither the MPEP nor current patent law supports the Patent Office's position. As such, Applicant requests the Commissioner to withdraw the holding of abandonment.

In the Office Action mailed 8 November 2005, the Examiner noted that the Board of Patent Appeals and Interferences affirmed the rejections of independent claims 1 and 15 and 23, but reversed the rejections of claims 9 and 18, which depend from claims 1 and 15, respectively. As a result, the Examiner issued a new Office Action that cancelled rejected independent claims 1, 15, and 23 in accordance with MPEP §1214.06, and stated: "Applicant is given a ONE MONTH TIME PERIOD from the mailing date of this letter in which to present the dependent claim(s) in independent form to avoid ABANDONMENT of the application."

Applicant mailed a response on 1 December 2005, well within the one-month time limit. In this response, Applicant cancelled all pending claims (1, 2, 4 – 8, 9 – 16, and 18 – 24), and added new claims 25 – 42. In the remarks portion of the response, Applicant stated:

New independent claim 25 corresponds to previously pending claims 1 and 9, while new independent claim 39 corresponds to previously pending claims 15 and 18. New dependent claims 26 – 41 and 40 – 42 correspond to the previously pending dependent claims. No new matter is added.

As such, Applicant stated that new claim 25 included the limitations of claim 1 and the limitations of claim 9, which the Board found to be allowable, and that new claim 39 included the limitations of claim 15 and the limitations of claim 18, which the Board also found to be allowable. Further, Applicant represented to the Patent Office that the remaining new claims corresponded to or were equivalent to the dependent claims that were pending in the application. Because these new dependent claims depend from claim 25 or claim 39, which the

Board held were allowable, and because these new dependent claims were examined during prosecution, these new dependent claims are obviously allowable.

In the Notice of Abandonment mailed 31 January 2006, the Examiner asserted that the reason for the abandonment was that the new claims filed with Applicant's response would require further consideration. However, no new claims were added. Applicant simply amended the independent claims as required by the Examiner and re-numbered the dependent claims. Applicant discussed this matter with Examiner Joseph Hall (the SPE) on 8 February 2006. Mr. Hall took the position that the MPEP requires Applicant to cancel all of the previously rejected dependent claims even though the corresponding independent claim has been amended to place it in condition for allowance. Applicant believes that Mr. Hall misinterpreted relevant sections of the MPEP. Further, Mr. Hall ignored relevant sections of the MPEP that authorized Mr. Hall to accept the response.

MPEP §1214.06(B) states that if the Board affirms a rejection against an independent claim and reverses all rejections against a dependent claim thereon, the examiner should either (emphasis added):

- (1) Convert the dependent claim into independent form by examiner's amendment, cancel all claims in which the rejection was affirmed, and issue the application; **OR**
- (2) Set a 1-month time limit in which appellant may rewrite the dependent claim(s) in independent form. Extensions of time under 37 CFR 1.136(a) will not be permitted. If no timely reply is received, the examiner will cancel all rejected and objected to claims and issue the application with the allowed claims only.

Section 1214 allows the Examiner to either make an Examiner's amendment or to issue an Office Action. The Examiner chose option 2 and issued an Office Action dated November 8, 2005. Nothing in Section 1214 requires Applicant to cancel all dependent claims. Subpart 1 explicitly authorizes the Examiner to cancel all claims for which the rejection was affirmed by the Board. However, subpart 2 does not require the Applicant to do so in the response. In fact,

subpart 2 requires only that the allowable dependent claims be rewritten in independent form, but is silent about the actions that must be taken as to the other dependent claims. It is a well-settled rule of statutory construction that a provision explicitly stated in one provision may not be read into another where the provision is omitted. Further, nothing in the Office Action mailed 8 November 2005 required Applicant to also cancel all rejected dependent claims. Thus, Applicant filed a proper response within the allocated time period. For at least this reason, the Notice of Abandonment was improper and should be withdrawn.

Further, Applicant notes that even if the Examiner believed that the response was improper or not timely filed, the Examiner was not required to hold the application abandoned..MPEP §1214.06 allows the Examiner to cancel all rejected claims and issue the application with the allowed claims when no timely response is filed. As such, MPEP §1214.06 allows the Examiner to make an examiner's amendment, even after the 1-month response time period has expired to put the case in condition for allowance. Under this provision, the Examiner could have made an Examiner's amendment to place the application in condition for allowance

In addition, MPEP §1214.07 states (emphasis added):

Sometimes an amendment is filed after the Board's decision which does not carry into effect any recommendation made by the Board and which presents a new or amended claim or claims. In view of the fact that \* prosecution is closed, the appellant is not entitled to have such amendment entered as a matter of right. However, if the amendment is submitted with a request for continued examination (RCE) under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e), \* prosecution of the application will be reopened and the amendment will be entered. See MPEP § 706.07(h), paragraph XI. Note that the RCE practice under 37 CFR 1.114 does not apply to utility or plant patent applications filed before June 8, 1995 or to design applications. See 37 CFR 1.114(d) and MPEP § 706.07(h), paragraph I. **If the amendment obviously places an application in condition for allowance, regardless of whether the amendment is filed with an RCE, the primary examiner should recommend that the amendment be**

**\*>entered<, and with the concurrence of the supervisory patent examiner, the amendment will be entered.**

In the telephone interview of 8 February 2006, Mr. Hail (the SPE) acknowledged that both he and the Examiner were unaware of the allowances made by MPEP §1214.07. Because Applicant's response presented allowable dependent claims 9 and 18 in independent form (new claims 25 and 39), because all "new" dependent claims are verbatim representations of the previously examined and §112-compliant dependent claims, and because all "new" dependent claims depend from allowable independent claims 25 and 39, Applicant clearly placed the application in condition for allowance. Indeed, the Examiner does not dispute that the claims are in condition for allowance. As such, in accordance with MPEP §1214.07, the Examiner should have entered the response. For at least this reason, the Notice of Abandonment should be withdrawn.

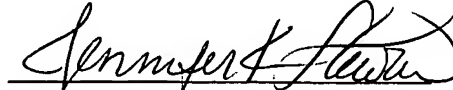
In addition, MPEP §2266.01 allows the Examiner to issue a new office action if Applicant's response is a *bona fide* attempt to respond, but contains a minor deficiency. As discussed above, Applicant clearly made a *bona fide* attempt to respond to the one-month Office Action issued by the Examiner. As such, under this provision, the Examiner could have issued a new Office Action to give the Applicant an opportunity to address the alleged deficiencies of the previous response.

In summary, Applicant filed a response that complies with the stated requirements of the MPEP within the required one-month time limit. Applicant should not be punished because the Examiner believed that non-stated requirements applied to Applicant or because the Examiner chose to ignore or was unaware of the various provisions provided by the MPEP to address the alleged deficiencies. Therefore, Applicant respectfully requests that the Commissioner withdraw the holding of abandonment and enter Applicant's amendments.

While no fees should be required for entry of this response, if any fees or charges are required, the Commissioner is hereby authorized to charge them to Deposit Account 18-1167.

Respectfully submitted,

COATS & BENNETT, P.L.L.C.



Jennifer K. Stewart  
Registration No.: 53,639

Dated: 13 March 2006

P.O. Box 5  
Raleigh, NC 27602  
Telephone: (919) 854-1844  
Facsimile: (919) 854-2084